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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,635	11/02/2001	Joseph C. Salamone	P02866	8360
7590	05/11/2004		EXAMINER PENG, KUO LIANG	
Bausch & Lomb Inc. One Bausch & Lomb Place Rochester, NY 14604-2701			ART UNIT 1712	PAPER NUMBER
DATE MAILED: 05/11/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,635

Applicant(s)

SALAMONE ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/5/04 Amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-13 and 19-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicants' amendment filed on February 5, 2004 was received. Claim 7 is amended. Now, Claim 7-13 and 19-28 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 7-13 and 19-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner cannot find the basis for "a modulus of approximately 5,000 g/mm² or less" recited in Claim 7 in the specification, e.g., Table 1. Furthermore, "If the original executed oath or declaration filed on the filing date of the application fails to refer to the preliminary amendment which was included with the application papers on filing, the preliminary amendment will not be considered part of the original disclosure". See MPEP 608.04(b).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1712

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 7-13 and 19-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Kunzler (US 5 710 302).

Kunzler discloses a polymeric composition produced through the polymerization of a monomer mixture comprising a monomer represented by Formula I (wherein m is greater than 2) and/or a monomer represented by Formula VI (wherein some of R¹⁹ can independently be a lower alkyl radical (i.e., can be C₂, C₃, etc. alkyls) or a phenyl radical). (col. 2, line 65 to col. 3, line 33 and col. 4, lines 16-26). Note that Formula I (with m not being 1) reads on Applicants' siloxysilane monomer recited in Claim 17 wherein y is not 1. Formula I (with m being 1, i.e., Formula II) and Formula VI both read on Applicants' siloxysilane monomer recited in Claim 17 wherein y is 1. Especially note that R₁, R₂, R₃ and R₄ in Formula I can independently be siloxane groups in addition to being alkyl groups, etc. (col. 3, line 62 to col. 4, line 1). Crosslinking agents such as di(meth)acrylate of triethylene glycol, N'N'-dihydroxyethylene-bisacrylamide, etc. can be used (col. 9, lines 29-62). Toughening agents such as cycloalkyl (meth)acrylates, methyl (meth)acrylate can be used (col. 9, line 63 to col. 10, line 34). Note that the toughening agents are typically hydrophobic. Hydrophilic monomers such as DMA, etc. can be used (col. 11, line 46 to col. 12, line 11). The modulus of the polymeric composition can be far less than 5,000 g/mm². (Examples).

6. Claims 7-11, 13 and 19-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Meijs (US 5 981 615).

Art Unit: 1712.

Meijs discloses a polymeric composition produced through the polymerization of a monomer mixture comprising a macromer of formula (IVA) (col. 6, lines 24-39). Note that PDMS in formula (IVA) can be a residue of bishydroxyalkyl terminated poly(dimethylsiloxane) (col. 6, line 61 to col. 7, line 12 and Example 2). As such, Meijs formula (IVA) reads on Applicants' siloxysilane monomer recited in Claim 17 wherein two of y's are 0 and one of the y's is 1. Hydrophilic monomers such as DMA, etc. can be used (col. 8, line 36 to col. 9, line 6). Hydrophobic monomers such as 2-ethylhexyl acrylate, etc. can be used (col. 8, lines 1-35). Cyclohexyl acrylate can be used (col. 8, lines 18-32), which reads on Applicants' strengthening agents. Crosslinking agents such as lower alkylene glycol di(meth)acrylates, etc. can be used (col. 9, lines 40-47). The typical modulus of the polymeric composition is far less than 5,000 g/mm² (Examples), e.g., 0.55 MPa (Examples 2 and 8).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meijs.

Meijs discloses a polymeric composition produced through the polymerization of a monomer mixture comprising a macromer of formula (IVA), *supra*, which is incorporated herein by reference. Meijs teaches the use of 2-ethylhexyl acrylate (col. 8, line 20). Furthermore, Meijs

Art Unit: 1712

teaches the use of C₁-C₁₈ alkyl acrylates and methacrylates. In other words, Meijs teaches the interchangeability between C₁-C₁₈ alkyl acrylate and C₁-C₁₈ alkyl methacrylates. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use 2-ethylhexyl methacrylate in Meijs' composition with expected success.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091.

The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

klp
May 6, 2004


Kuo-Liang Peng
Primary Examiner
Art Unit 1712